

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 30, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Reidl Uhrengrosshandels-Gesellschaft m.b.H.
v.
Viva Time Corp.

Opposition No. 98,504
to application Serial No. 74/542,908
filed on June 27, 1994

Mark D. Engelmann of Fross Zelnick Lehrman & Zissu, P.C. for
Reidl Uhrengrosshandels-Gesellschaft m.b.H.

Ezra Sutton of Ezra Sutton, P.A. for Viva Time Corp.

Before Hairston, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An intent-to-use application has been filed by Viva
Time Corp. to register the mark JACQUES LAURENT for watches,
key chains made of precious metals, and jewelry in class 14;
and attaché cases, handbags, purses, wallets, and leather
key cases and accessories in class 18.¹

¹ Application Serial No. 74/542,908 filed June 27, 1994. The
application contains the following statement: "The name shown in

Registration has been opposed by Reidl Uhrengrosshandels-Gesellschaft m.b.H. under Section 2(d) of the Trademark Act on the ground of likelihood of confusion between applicant's mark and opposer's mark JACQUES LEMANS for watches and alarm clocks. Opposer alleges that it is the owner of application Serial No. 74/434,169, filed September 9, 1993, for said mark and goods.²

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

We turn first to an evidentiary matter. On August 24, 1998, applicant submitted its brief on the case which included a list of third-party registrations for marks which include the name "Jacques." On the same date, applicant filed a motion to reopen its testimony period to submit certified copies of these third-party registrations. Applicant stated that opposer would not be prejudiced by the granting of the motion because applicant had advised opposer of the third-party registrations during discovery. Further, applicant stated that it had requested certified copies of the registrations from the PTO, but that they had not yet

the mark does not identify a living individual. It is a fanciful and arbitrary name."

² Although the application was initially filed under Section 1(b) of the Trademark Act (intent-to-use), it was subsequently amended to assert Section 44(e) as the basis therefor. The application contains the following statement: "Jacques Lemans is not known to be the name of any particular living individual." We note that Office records show that this application issued as Registration No. 2,218,014 on January 19, 1999.

been received by applicant. Attached to the motion was a copy of applicant's request dated January 23, 1998.

Opposer, in its reply brief filed September 9, 1998, has opposed the motion to reopen and also argues that no consideration should be given to the list of registrations in applicant's brief. The Board, in an order mailed January 13, 1999, deferred action on applicant's motion to reopen until final hearing.

The showing that must be made to reopen a prescribed period under the Federal Rules of Civil Procedure is set forth at Rule (6)(b), made applicable to Board proceedings by Trademark Rule 2.116(a). Rule 6(b) provides for an enlargement of time after the expiration of the specified time period, "where the failure to act was the result of excusable neglect."

As clarified by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), and followed by the Board in *Pumpkin, Ltd. v. The Seeds Corps*, 43 USPQ2d 1582 (TTAB 1997), the inquiry as to whether a party's neglect is excusable is:

at bottom an equitable one, taking into account all relevant circumstances surrounding the party's omission. These include ... (1) the danger of prejudice to the [nonmovant], (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason

for the delay, including whether it was within the reasonable control of the nonmovant, and (4) whether the movant acted in good faith.

Pioneer, 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third Pioneer factor, namely the reason for the delay and whether it was in the reasonable control of the movant, might be considered the most important factor in a particular case. See Pumpkin Ltd. at 1586, footnote 7 and the cases cited therein.

Initially, we consider the third Pioneer factor, and we find that applicant's failure to make copies of the third-party registrations of record during its testimony period was due to circumstances wholly within its control. First, we must point out that it was not necessary that copies of the third-party registrations be certified or show current status and title. Plain copies of the registrations themselves, or the electronic equivalent thereof, that is, printouts of the registrations from the electronic records of the PTO's trademark automated search system would have been sufficient. See TBMP §703.02 and cases cited therein. More importantly, applicant has offered no explanation for its failure to timely move to extend its testimony period when it realized it would be unable to submit copies of the registrations during its testimony period. Applicant had an obligation to file, prior to the close of its testimony period, a motion to extend said period.

As regards the remaining Pioneer factors, while we find no evidence of a bad faith attempt by applicant to delay this case, opposer would be prejudiced by the introduction of new evidence at this stage of the proceeding. Further, the delay in applicant's defense of this case is detrimental to the orderly administration of the opposition process.

In view of the foregoing, applicant's motion to reopen its testimony period is denied. Also, opposer's objection to the list of third-party registrations in applicant's brief is well-taken. A party may **not** make third-party registrations of record simply by introducing a list of such registrations. See TBMP §703.02(b) and cases therein. Also, evidentiary materials attached to a party's brief can be given no consideration unless they were properly made of record during the party's testimony period. See TMBP §§705.02 and 801.01. Further, factual statements made in a party's brief can be given no consideration unless they are supported by evidence properly made of record. See TBMP §706.02. Thus, we have given no consideration to the list of third-party registrations in applicant's brief, or applicant's arguments in connection therewith, in reaching our decision herein.

The record consists of the pleadings; the file of the involved application; and the file of opposer's application and applicant's responses to opposer's interrogatories, made

of record by way of opposer's notice of reliance. Applicant neither took testimony nor introduced any other evidence. Both parties submitted briefs on the case.

Because of the sparse record in this case, little is known about the parties. Applicant, in response to opposer's interrogatories, indicated that it selected the mark JACQUES LAURENT because it had a French connotation. Also, applicant indicated that the wholesale price of its watches will be between \$20.00 and \$30.00 and that it intends to sell its watches through retail and department stores.

We turn to the merits of this opposition proceeding. Insofar as priority is concerned, opposer filed its application on September 9, 1993 which is prior to June 27, 1994, the filing date of applicant's application. Thus, in the present case, priority rests with opposer. See Section 7(c) of the Trademark Act.

With respect to the issue of likelihood of confusion, two key considerations are the similarities between the marks and the similarities between the goods. In this case, the goods are identical, i.e., watches. The goods are assumed to move in the same channels of trade to the same classes of purchasers. Moreover, we assume that the purchasers of the parties' products are ordinary consumers.

We focus our attention then on the involved marks. It is opposer's position that the marks are nearly identical in overall commercial impression because each mark has a French connotation and consists of the given name JACQUES and a surname which begins with the letter "L."

Notwithstanding opposer's argument, we believe that in this case, it is appropriate to give greater weight to the surname portions of the marks. In this regard, the Board has recognized the practice of identifying or referring to individuals (and their names used as trademarks) by surnames alone. *Seligman & Latz, Inc. v Merit Mercantile Corp.*, 222 USPQ 720, 722 (TTAB 1984). See also *Nina Ricci, S.A.R.L. v Haymaker Sports, Inc.*, 134 USPQ 26, 28 (TTAB 1962) and *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 512 (TTAB 1984) [It is common in the fashion industry to refer to designers by their surnames alone]. The surnames LAURENT and LEMANS are obviously different in sound, appearance and connotation and, thus, when we consider the marks in their entireties, giving appropriate weight to the surnames, we find that JACQUES LAURENT and JACQUES LEMANS create different commercial impressions.

We note opposer's reliance on *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1984) wherein the Board held that applicant's mark DUCA D'AREZZO (stylized) for clothing was likely to cause

confusion with opposer's mark DUCA D' AOSTA for identical goods. That case is distinguishable, however, because each of the marks therein consisted of a title and place name, not a given name and surname.

In sum, notwithstanding the identity of the goods, we find that the marks JACQUES LAURENT and JACQUES LEMANS are sufficiently different that confusion is not likely.

Decision: The opposition is dismissed.

P. T. Hairston

H. R. Wendel

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board